

REMARKS

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-28 are pending in this application.

Double Patenting Rejection

The Examiner provisionally rejects claims 1 and 16 on double patenting grounds over claim 5 of U.S. Patent Application No. 10/876,048. *See* Current Action, pgs. 2-3. Applicant proposes filing a terminal disclaimer with respect to the rejected claims upon indication that such claims are allowable.

Rejection Under 35 U.S.C. 112(2)

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In the Current Action the Examiner takes issue with, for example, “using said calculated probabilities,” as set forth in the claims. *See, for example*, Current Action, paragraph 7. Specifically, the Examiner opines that in view of this limitation “it is unclear what method/process applicant is intending to encompass.” The Examiner further states “[a] claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.” *Id.* As Applicant best understands, the Examiner relies upon *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1966) to support the rejections of record. (Applicant notes that the Examiner cites these cases in a paragraph seemingly related to the rejection under 35 U.S.C. 101, but then combines all rejections under a 35 U.S.C. 112, second paragraph, rejection heading. As such, Applicant endeavors to address the Examiner’s reliance upon these cases in either context). As an initial matter, Applicant recognizes that inventions involving new ways to use materials to effectuate a beneficial result may raise the issue of indefiniteness under Section 112, second paragraph, or statutory subject matter under Section 101. However, Applicant points out that the pending claims, as recited, sufficiently make clear the subject matter which they encompass.

Applicant notes that the Examiner's reliance upon *Ex parte Dunki* is misplaced. In *Ex parte Dunki*, the claims at issue read as follows:

1. A vehicle brake part subjected to stress by sliding friction, consisting of a high-carbon, austenitic iron alloy having a proportion of free carbon.
12. The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction.

The relevant issue before the Appeal Board was whether or not the Appellant's claim was in the proper form. "[A]ccording to the examiner, [the language of the claims] embraces many parts of a brake system, and he insists that appellant's alleged new use should be expressed in method form (emphasis added). Applicant notes that its claims, in contrast to claim 12 before the Board in *Ex parte Dunki*, are in proper method form. In further contrast to the claims before the *Ex parte Dunki* Board, each claim recites active, positive steps (e.g., claim 1 recites the steps of "detecting," "calculating," "communicating," and "routing"). In upholding the rejection of claim 12, the *Ex parte Dunki* Board relied upon the reasoning set forth in *Clinical Products Ltd. v. Brenner* to support its decision. However, as will be discussed, *Clinical Products* is clearly distinguishable from the case at hand as well.

In *Clinical Products*, the claim at issue reads as follows:

41. The use as a sustained release therapeutic agent in the body of ephedrine adsorbed upon polystyrene sulphonic acid.

As an initial matter, Applicant notes that the Court found this claim to be definite under 35 U.S.C. 112. In doing so, the Court noted that 35 U.S.C. 112, second paragraph, "provides considerable leeway to the applicant, if and provided that his claims include all truly essential limitations and do not utilize vague and ambiguous terms. *Clinical Products*, 149 USPQ at 477. In upholding the rejection under 35 U.S.C. 101, the Court reasoned that "[a] new 'use' of a known composition or matter can be properly claimed only by claiming the invention as a

process or method.” *Id* (emphasis added). First, Applicant’s claimed invention is not drawn to a “new use,” instead, the claims are drawn to, for example, “a method for operating a sensor net.” Also, Second, Applicant again points out that, in contrast to the claims at issue in the Examiner’s cited cases, the pending claims are proper method claims.

In a more recent case, and one where the claims at issue were similar to the pending claims, the Board determined the claims at issue to be statutorily appropriate. In *Ex parte Porter*, 25 U.S.P.Q.2d 1144 (Bd. Pat. App. & Inter. 1992), an exemplary claim at issue read as follows:

6. A method for unloading nonpacked, nonbridging and packed, bridging flowable particle catalyst and bead material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 7

Similar to the case at hand, the Board noted that the Examiner “considers that claim 6 does not ‘provide any steps to define the method.’” *Ex parte Porter*, 25 U.S.P.Q.2d at 1146. However, in overturning the Examiner’s rejection, the Board observed:

“The manner in which claim 6 has been drafted has been an acceptable format for years.... Contrary to the examiner’s assertion that claim 6 has no step, the claim clearly recites the step of ‘utilizing.’” *Id.* at 1147.

In the case at hand, the pending claims are most similar to those before the Board in *Ex parte Porter*. That is, the pending claims recite positive method steps (e.g., “calculating,” “communicating,” “routing”) and further recite the step of “utilizing.” As such, Applicant submits that the claims are definite under 35 U.S.C. 112, second paragraph, and are appropriate statutory subject matter under 35 U.S.C. 101. Therefore, Applicant requests withdrawal of the rejections of record.

Rejection Under 35 U.S.C. 101

Claims 1-28 are rejected under 35 U.S.C. 101 "because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process...." *See, for example*, Current Action, paragraph 7. As an initial matter, Applicant points out that its claims do recite steps involved in a process. As such, the Examiner's implication that the claims do not "set forth any steps involved in the process" is inaccurate. Moreover, as Applicant explained above, the case at hand is clearly distinguishable from the cases relied upon by the Examiner. Therefore, according to rationale set forth above, Applicant submits that the claims are appropriate subject matter under 35 U.S.C. 101. Therefore, Applicant requests withdrawal of the 35 U.S.C. 101 rejection of record.

Conclusion

In view of the remarks above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10040054-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV568269284US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit: February 23, 2007

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Respectfully submitted,

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